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10/671,320

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Robin B. Hutchison

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CHRISTENSEN, O'CONNOR, JOHNSON, KINDNESS, PLLC
1420 FIFTH AVENUE
SUITE 2800
SEATTLE, WA 98101-2347

EXAMINER

FERTIG, BRIAN E

ART UNIT

PAPER NUMBER

4124

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/671,320	Applicant(s) HUTCHISON ET AL.	
	Examiner BRIAN FERTIG	Art Unit 4124	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/1/2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/1/2007; 2/18/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 2/18/2004 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because NPL references do not appear in the present or parent filings. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Claim Objections

2. Claims 16, 17, and 28 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

With respect to claims 16 and 17

Claim 16 depends on itself and Claim 17 depends on claim 16 and incorporates its improper dependence. For the purposes of examination below, it is assumed that claim 16 depends from claim 15.

With respect to claim 28

This claim recites "said purchase request identifying a virtual payment account as the method of payment for said product". "Said purchase request" lacks antecedent basis within the claims. For the purposes of examination below, it is assumed that said purchase request is meant to refer to "a report".

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 2-5, 9, 13, 14, 21-26, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,557,518 to Rosen (Rosen).

With respect to claim 2

Rosen teaches:

A method for purchasing a product from a merchant computer using a virtual payment account, comprising:

receiving a request from a consumer computer to purchase a product from said merchant computer using a virtual payment account (see col 17, lines 50-54 and fig 12 and 21);

in response to said purchase request, determining whether said consumer computer is associated with a virtual payment

account maintained by a commerce gateway (see col 24, lines 32-40 and fig 12 and 21);

in response to determining that said consumer computer is associated with said virtual payment account, applying a cost of said product to said virtual payment account (see col 24, lines 47-48 and fig 12 and 21); and

providing said product to a consumer associated with said consumer computer (see col 18, lines 35-42 and col 24, lines 49-63, note that the customer is provisionally provided with the merchandise before the payment transaction is complete and then may use the product once the transaction is complete)

With respect to claim 3

Rosen teaches:

The method of Claim 2 (see rejection of claim 2 above), wherein determining whether said consumer computer is associated with a virtual payment account comprises:

transmitting an authentication request from said consumer computer to a commerce gateway (see col 26, lines 57-59 and Fig 26);

determining at said commerce gateway whether a valid virtual payment account is associated with said consumer computer (see col 26, lines 57-59, and fig 26);

transmitting an account identification container to said consumer computer in response to determining that said consumer computer is associated with a valid virtual payment account (see col 27, lines 5-14 and Fig 26).

With respect to claim 4

Rosen teaches:

The method of Claim 3 (see rejection of claim 3 above), wherein said authentication request comprises a digital certificate (see col 27, lines 5-9).

With respect to claim 5

Rosen teaches:

The method of Claim 3 (see rejection of claim 3 above), wherein applying a cost of said product to said virtual payment account comprises:

receiving said account identification container at said merchant computer (see col 24, lines 26-29 and fig 21);

transmitting said account identification container and said cost of said product from said merchant computer to said commerce gateway (see col 24, lines 26-40 and fig 21);

determining whether said virtual payment account may be charged for said cost of said product (see col 24 lines 35-40 and fig 21); and

in response to determining that said virtual payment account may be charged for said cost of said product, transmitting a valid transaction authorization from said commerce gateway to said merchant computer (see col 24, lines 35-60 and fig 21).

With respect to claim 9

Rosen teaches:

A method for purchasing a product from a merchant server using a virtual payment account associated with a consumer computer, the method comprising:

receiving a request from said consumer computer to purchase said product, said purchase request identifying a virtual payment account as the method of payment for said product (see col 17, lines 50-54 and fig 12 and 21);

in response to said purchase request, transmitting an authentication request from said consumer computer to a commerce gateway (see col 24, lines 26-40 and fig 21, note that the authentication information is sent by the consumer computer to the commerce gateway, by way of the merchant computer);

receiving said authentication request at said commerce gateway and determining whether a valid virtual payment account is associated with said consumer computer at said commerce gateway (see col 24 lines 35-40);

in response to determining that a valid virtual payment account is associated with said consumer computer, transmitting an account identification container to said consumer computer (see col 27, lines 5-14 and Fig 26);

transmitting said purchase request including said account identification container from said consumer computer to said merchant server (see col 27, lines 5-14 and Fig 26);

transmitting said purchase request from said merchant computer to said commerce gateway (see col 24, lines 26-40 and fig 21);

receiving said purchase request at said commerce gateway and determining whether said virtual payment account may be used to pay for said product (see col 24, lines 26-40 and fig 21);

in response to determining that said virtual payment account may be used to pay for said product, transmitting a valid transaction authorization from said commerce gateway to said merchant computer and said consumer computer (see col 24, lines 35-60 and fig 21);

charging said virtual payment account for a cost associated with said product (see col 24, lines 47-48 and fig 12 and 21); and

providing said product to a consumer associated with said consumer computer (see col 18, lines 35-42 and col 24, lines 49-

63, note that the customer is provisionally provided with the merchandise before the payment transaction is complete and then may use the product once the transaction is complete).

With respect to claim 13

Rosen teaches:

The method of Claim 9 (see rejection of claim 9 above), wherein said virtual payment account comprises a credit account (see col 24, lines 10-11).

With respect to claim 14

Rosen teaches:

The method of Claim 9, wherein said virtual payment account comprises a pre-paid account (i.e. debit card, see col 24, lines 10-11).

With respect to claim 21

Rosen teaches:

An apparatus for purchasing a product from a merchant computer using a virtual payment account associated with a consumer computer over an internetwork comprising:

a consumer computer (i.e. consumer transaction device)
comprising

a network interface for connecting to said
internetwork (i.e. communications function, see col 8,
lines 13-21)

a processing unit coupled to said network interface (i.e. host processor, see col 8, lines 1), and
a storage medium coupled to said processing unit (i.e. transaction applications, see col 8, lines 22-34);
a merchant computer (i.e. merchant transaction device) comprising
a network interface for connecting to said internetwork (i.e. communications function, see col 8, lines 13-21),
a processing unit coupled to said network interface (i.e. host processor, see col 8, lines 1), and
a storage medium coupled to said processing unit (i.e. transaction applications, see col 8, lines 22-34);
a commerce gateway (i.e. trusted servers) comprising
a network interface for connecting to said internetwork (i.e. implied by existence of network, distribution functions, and figure 5, see col 10, lines 41-67),

a processing unit coupled to said network interface (i.e. tamper proof processors, see col 10, lines 41-67)

a storage medium coupled to said processing unit (i.e. implied by storage of public keys, see col 10, lines 41-67); and

wherein said storage medium of said consumer computer contains program code executed by said consumer computer processing unit for transmitting a request to said merchant computer to purchase a product, said purchase request identifying a virtual payment account as the method of payment for said product (see col 17, lines 50-54, col 24, lines 26-28, and fig 12 and 21); and

wherein said storage medium of said merchant computer contains program code executed by said merchant computer processing unit for requesting the identity of a valid virtual payment account associated with said consumer computer in response to receiving a purchase request from said consumer computer (see col 24, lines 21-40); and

wherein said storage medium of said commerce gateway contains program code executed by said commerce gateway processing unit for determining whether a valid virtual payment

account is associated with said consumer computer, and for transmitting an account identification container to said consumer computer in response to determining that a valid virtual payment account is associated with said consumer computer (see col 27, lines 5-14 and Fig 26).

With respect to claim 22

Rosen teaches:

The apparatus of Claim 21 (see rejection of claim 21 above), wherein said storage medium of said consumer computer further contains program code executed by said consumer computer processing unit for receiving said account identification container from said commerce gateway, and for transmitting a purchase request to said merchant computer including said account identification container (see col 24, lines 26-29).

With respect to claim 23

Rosen teaches:

The apparatus of Claim 22 (see rejection of claim 22 above), wherein said storage medium of said merchant computer further contains program code executed by said merchant computer processing unit for receiving said purchase request from said consumer computer, and for transmitting said purchase request to said commerce gateway (see col 24, lines 26-40).

With respect to claim 24

Rosen teaches:

The apparatus of Claim 23 (see rejection of claim 23 above), wherein said storage medium of said commerce gateway further contains program code executed by said commerce gateway processing unit for receiving said purchase request, and for determining whether said virtual payment account may be used to pay for said product (see col 24, lines 26-40).

With respect to claim 25

Rosen teaches:

The apparatus of Claim 24 (see rejection of claim 23 above), wherein said storage medium of said commerce gateway further contains program code executed by said commerce gateway processing unit for transmitting a valid transaction authorization to said merchant computer in response to determining that said virtual payment account may be used to pay for said product (see col 24, lines 26-40).

With respect to claim 26

Rosen teaches:

The apparatus of Claim 25 (see rejection of claim 25 above), wherein said storage medium of said commerce gateway further contains program code executed by said commerce gateway processing unit for charging said virtual payment account for a cost associated with said product (see col 24, lines 47-48 and fig 12 and 21).

With respect to claim 28

Rosen teaches:

A computer-readable medium having a computer-executable component for purchasing a product from a merchant computer using a virtual payment account, the computer-executable component comprising instructions which when executed by the computer cause the computer to transmit a report to a merchant computer to purchase a product, said purchase request identifying a virtual payment account as the method of payment for said product (see col 17, lines 50-54, col 24, lines 26-28, and fig 12 and 21).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 6-8, 10-12, 18-20, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosen in view of US Patent 5,610,980 to Johnson (Johnson).

With respect to claim 6

Rosen teaches:

The method of Claim 3 (see rejection of claim 3 above), but does not explicitly teach wherein said virtual payment account comprises a main account and at least one sub-account.

Johnson teaches:

wherein said virtual payment account comprises a main account and at least one sub-account (see col 58, line 6—col 59, line 32)

It would have been obvious to one skilled in the art at the time of applicant's invention to provide the method taught by Rosen with the sub-account features taught by Johnson in order to provide tools to allow customers to more easily manage their accounts as taught implicitly by Johnson.

With respect to claim 7

Rosen as modified by Johnson teaches:

The method of Claim 6 (see rejection of claim 6 above), wherein said sub-account is operative only to accept charges from a predetermined list of merchant computers (i.e. limitations based on retailer code, see Johnson col 58, line 6—col 59, line 32).

(see rationale supporting obviousness and motivation to combine of claim 6 above)

With respect to claim 8

Rosen as modified by Johnson teaches:

The method of Claim 6 (see rejection of claim 6 above), wherein a spending limit may be set by said consumer for said sub-account. (see Johnson col 58, line 6—col 59, line 32).

(see rationale supporting obviousness and motivation to combine of claim 6 above)

With respect to claim 10

Rosen teaches:

The method of Claim 9 (see rejection of claim 9 above), but does not explicitly teach wherein said virtual payment account comprises a main account and at least one sub-account.

Johnson teaches:

wherein said virtual payment account comprises a main account and at least one sub-account. (see col 58, line 6—col 59, line 32)

It would have been obvious to one skilled in the art at the time of applicant's invention to provide the method taught by Rosen with the sub-account features taught by Johnson in order to provide tools to allow customers to more easily manage their accounts as taught implicitly by Johnson.

With respect to claim 11

Rosen as modified by Johnson teaches:

The method of Claim 10 (see rejection of claim 10 above), wherein charging said virtual payment account for a cost associated with said product comprises charging said sub-account for a cost associated with said product (see col 58, line 6—col 59, line 32).

(see rationale supporting obviousness and motivation to combine of claim 10 above)

With respect to claim 12

Rosen as modified by Johnson teaches:

The method of Claim 11 (see rejection of claim 11 above), further comprising:

determining whether said sub-account is authorized to receive a charge from said merchant computer (i.e. checking to see whether merchant is subject to the limitations based on retailer code see Johnson, col 58, line 6—col 59, line 32) ; and

charging said sub-account for a cost associated with said product in response to determining that said sub-account is authorized to receive said charge from said merchant server (see Rosen col 24, lines 47-48 and fig 12 and 21).

(see rationale supporting obviousness and motivation to combine of claim 10 above)

With respect to claim 18

Rosen as modified by Johnson teaches:

The method of Claim 10 (see rejection of claim 10 above), wherein determining whether said virtual payment account may be used to pay for said product comprises determining whether a spending limit has been exceeded (see Johnson col 58, line 6—col 59, line 32).

(see rationale supporting obviousness and motivation to combine of claim 10 above)

With respect to claim 19

Rosen as modified by Johnson teaches:

A computer-controlled apparatus (see Rosen, col 7, line 65 – col 8, line 53) for performing the method of Claim 10 (see rejection of claim 10 above to rationale supporting rejection, obviousness, and motivation to combine).

With respect to claim 20

Rosen as modified by Johnson teaches:

A computer-readable medium (see Rosen, col 7, line 65 – col 8, line 53) containing instructions which, when executed by a computer, perform the method of Claim 10 (see rejection of claim 10 above to rationale supporting rejection, obviousness, and motivation to combine).

With respect to claim 27

Rosen teaches:

The apparatus of Claim 26 (see rejection of claim 26 above), but does not explicitly teach wherein said virtual payment account comprises a main account and a sub-account, and wherein said storage medium of said

commerce gateway further contains program code executed by said commerce gateway processing unit for charging said sub-account of said virtual payment account for a cost associated with said product.

Jonson teaches:

wherein said virtual payment account comprises a main account and a sub-account, and wherein said storage medium of said commerce gateway further contains program code executed by said commerce gateway processing unit for charging said sub-account of said virtual payment account for a cost associated with said product (see Johnson col 58, line 6—col 59, line 32).

It would have been obvious to one skilled in the art at the time of applicant's invention to provide the method taught by Rosen with the sub-account features taught by Johnson in order to provide tools to allow customers to more easily manage their accounts as taught implicitly by Johnson.

8. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosen in view of US Patent 6,119,105 to Williams (Williams).

With respect to claim 15

Rosen teaches:

The method of Claim 9 (see rejection of claim 9 above), wherein said authentication request comprises a digital certificate (see col 24, lines 27-29),

Rosen does not explicitly teach:

wherein said digital certificate is transmitted to said commerce gateway
via a secure link.

Williams teaches:

wherein said digital certificate is transmitted to said commerce gateway
via a secure link (see col 22, lines 33-40).

It would have been obvious to one skilled in the art at the time of applicant's
invention to have provided the method taught by Rosen with the secure link
taught by Williams in order to prevent confidential banking information from being
intercepted by third parties as taught explicitly by Williams (see col 22, line 36)

With respect to claim 16

Rosen as modified by Williams teaches:

The method of Claim 16 (assumed to be claim 15, see objection and
rejection of claim 15 above), wherein said digital certificate is created at
said commerce gateway and is transmitted to said consumer computer at
the time a virtual payment account associated with said consumer
computer is created (see Rosen col 26, line 54-col 27, line 14 and Fig 26).

(see rational supporting obviousness and motivation to combine of claim 15
above)

With respect to claim 17

Rosen as modified by Williams teaches:

The method of Claim 16 (see rejection of claim 16 above), wherein said digital certificate is encrypted (see Rosen col 27, lines 5-14)
(see rational supporting obviousness and motivation to combine of claim 15 above)

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN FERTIG whose telephone number is (571)270-5131. The examiner can normally be reached on Monday - Friday 8:30am to 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kenneth Bomberg can be reached on (571) 272-4922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Mary Cheung/
Primary Examiner, Art Unit 3694